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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/414,547	10/08/1999	TOKIMORI TOMITA	122.1046-D/G	3462
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STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			EXAMINER KARMIS, STEFANOS	
			ART UNIT 3693	PAPER NUMBER
			MAIL DATE 12/17/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Advisory Action  
Before the Filing of an Appeal Brief**

<b>Application No.</b> 09/414,547	<b>Applicant(s)</b> TOMITA ET AL.
<b>Examiner</b> STEFANOS KARMIS	<b>Art Unit</b> 3693

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 26 November 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.  
NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.

6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: \_\_\_\_\_.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_

13. ☐ Other: \_\_\_\_\_.

/Stefanos Karmis/  
Primary Examiner, Art Unit 3693

Applicant's arguments with respect to claims 101-106 have been considered but are not persuasive. These arguments have already been addressed in the final rejection mailed 21 July 2008, and they are repeated/elaborated below. Applicant's request for reconsideration has not overcome the rejection and therefore claims 101-106 remain rejected.

Applicant argues that the cited prior art fails to teach "a customer dataset for stored cumulative points" and "sending the customer's current cumulative points stored in the customer database to the terminal prior to performing transaction by the customer based upon a result of said identifying the customer." The Examiner respectfully disagrees. Schultz teaches that the in-store computer system comprises an in-store data bank (database) for storing a plurality of files (column 9, lines 47-59). Schultz further teaches that the files include information related to consumers participating in a frequent shopper program and reward files containing information related to the purchase reward offer (column 9, lines 47-59). Schultz further teaches that the PMCS also includes a data bank which stores reward files and customer files identical to the in-store data bank (column 9, line 60 thru column 10, line 6). Schultz also teaches that customer file stores records of purchased items with associated rewards (column 10, lines 8-19). Schultz further teaches that the in-store computer receives purchase information for accumulating sales data and when participating in the marketing program, store the purchase records for the marketing program (column 7, lines 33-44). Further, Schultz teaches that from the product purchase records, the central management firm determines the consumer's earned rewards and sends a reward certificate to the consumer for those earned rewards (column 10, lines 20-28). Therefore, Schultz teaches a "a customer database for stored cumulative points." Examiner notes that Deaton also teaches the use of a customer database (column 68, steps 3-13).

Applicant's argument that Schultz fails to teach "sending the customer's current cumulative points stored in the customer database to the terminal prior to performing transaction by the customer based upon a result of said identifying the customer." As mentioned above, Schultz teaches providing a point balance to a customer via a report but fails to teach that the point balance is sent to the terminal after the customer identification and prior to performing a transaction by the customer.

Deaton teaches dissemination of Point-Of-Sale coupons that are earned based on previous transactions and shopping history of the customer (column 67, lines 56 thru column 68, line 12; Examiner notes that the coupons are analogous to the reward certificates taught in Schultz). Deaton teaches using a checking account ID to identify the customer at the point of sale (column 68, lines 13-67, see steps 6-13). Deaton further teaches that the coupon reward and other incentives are made at the point of sale terminal and applied to the current purchase (column 69, lines 46 thru column 70, line 46).

Nichtberger teaches a paperless system for distributing, redeeming and clearing merchandise coupons in which a customer presents his special card before the checkout process begins and the in-store computer unit receives the customer's coupons from the CDR and applies the coupons to items as they are being purchased before totaling the purchase amount (column 17, lines 30-61). Applicant argues that the teachings of Nichtberger are not enabled because Nichtberger notes that the system may not be "compatible with the design of some conventional system." The fact that Nichtberger mentions that his invention may not be compatible with some conventional systems does not equate to the invention being not enabled. Therefore this argument is not persuasive and the cited prior does teach "sending the customer's current cumulative points stored in the customer database to the terminal prior to performing transaction by the customer based upon a result of said identifying the customer."

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Schultz to include having the customer access their reward coupons as items are being purchased (before the purchase total) as taught by Deaton and Nichtberger because it allows the customer to take advantage of earned coupons/rewards through their shopping history (previous transactions) at the point of sale when items are being purchased rather than having to make another trip back to the store or having to remember to bring the physical coupon/reward. There is sufficient motivation to combine the teachings of Schultz with Deaton and Nichtberger because the reward certificates taught by Schultz act as earned coupons that can be applied for a discount or free gift. Schultz teaches that the reward certificate can be a voucher to be redeemed at the store for credit towards product purchases and is therefore applied similarly to the coupons taught by Deaton and Nichtberger. All these incentives provide for a means of gaining customer loyalty in a transaction environment.